

REMARKS

Claims 1-28 are pending in the present application. Claims 1-28 stand rejected. Claim 16 has been amended.

Indefiniteness Rejection

Claims 1 and 2 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. In particular, the Examiner asserts that “adapted” is “optional language” and “lacks positive recitation”. Applicant respectfully traverses the rejection as set forth below.

The Examiner failed to provide a citation to case law or the M.P.E.P. in support of the conclusion that “adapted” is “optional language”. It is respectfully requested that the Examiner provide a citation supporting the Examiner’s conclusion.

The Examiner failed to provide a citation to case law or the M.P.E.P. in support of the contention that “adapted” language “lacks positive recitation”. More importantly, the Examiner failed to provide a citation to case law or the M.P.E.P. in support for the allegation that “lacks positive recitation” is a bar to patentability. It is respectfully requested that the Examiner provide a citation supporting the Examiner’s conclusion.

For the sake of argument only, if the Examiner is asserting that Applicant is reciting function language, an assertion that Applicant need not confirm nor deny, then the attention of the Examiner is directed to M.P.E.P. § 2173.05(g) which states that “[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)”. M.P.E.P. § 2173.05(g) (Rev. 5, Aug. 2006) at page 2100-219.

With respect to the “adapted” language recited in claims 1 and 2, Applicant again respectfully draws the attention of the Examiner to M.P.E.P. § 2173.05(g) which discussed *In re Venezia*.

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as “members adapted to be positioned” ... serve to precisely define present structural attributes of interrelated component parts of the

claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

M.P.E.P. § 2173.05(g) (Rev. 5, Aug. 2006) at page 2100-220.

It is especially noteworthy and persuasive that these cases are Court of Customs and Patent Appeals cases.

Applicant respectfully submits that the Court of Customs and Patent Appeals had no problem with the “adapted” language and did not consider such language “optional”.

It is respectfully requested that the Examiner reconsider the rejection under 35 U.S.C. § 112, ¶ 2.

In addition, Applicant encourages the Examiner to visit the patent search page at the website of the United States Patent and Trademark Office:

<http://patft.uspto.gov/netahtml/PTO/search-adv.htm>

The Examiner is encouraged to enter the following search terms:

aclm/adapted

which will presumably bring up all the issued patents that have used the claim language “adapted” since 1976.

As of December 20, 2006, such a search would list **470,999 issued patents** with claims that use the term “adapted”.

Presumably, this is further evidence that “adapted” is used as part of ordinary and accepted practice before the United States Patent and Trademark Office.

It certainly demonstrates that using “adapted” is not a *per se* bar to patentability as evidenced by 470,999 issued patents since 1976.

For at least the above reasons, it is respectfully requested that rejection under 35 U.S.C. § 112, ¶ 2, be withdrawn with respect to claims 1 and 2.

Obviousness Rejections

Claims 1, 2, 11, 12, 16, 17 and 24 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,072,056 B1 (“Greaves”).

Claims 3-10, 12-15, 17-23 and 25-28 stand rejected under 35 U.S.C. § 103(a) as being obvious over Greaves in view of U.S. Patent No. 6,255,800 B1 ("Bork").

Thus, claims 1-28 stand rejected as being obvious based, at least in part, on Greaves.

Applicant respectfully traverses the rejections as set forth below.

Applicant respectfully submits that Greaves does not teach each and every element as alleged in the Office Action. Furthermore, where the obviousness rejection was based on Greaves in view of Bork, Applicant respectfully submits that Bork does not make up for the teaching deficiencies of Greaves.

For example, claim 1 recites "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device". Claim 11 recites "the electronic system not having to be aware of the first protocol to be in communications with the device". Claim 16 recites "wherein the personal computer does not have to be aware of the first protocol to be in communication with the device". Claim 24 recites "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device".

Greaves does not teach at least the above recited elements in independent claims 1, 11, 16 and 24.

In Greaves according to FIG. 1, sending device 12 using communication protocol A can communicate with destination device 14 using communication protocol B because gateway device 10 converts communication protocol A data into communication protocol B data.

However, sending device 12 is aware of the communication protocol that destination device 14 uses.

First, if sending device 12 and destination device 14 use the same protocol, then sending device 12 can send data directly to destination device 14 via communication link 20. The attention of the Examiner is respectfully directed to FIG. 1. FIG. 1 shows a communication link from sending device 12 directly to communication link 20 which, in turn, is directly connected to the destination device 14. Thus, if the sending device 12 can determine that the communication protocol used by the destination device 14 is the same as the communication protocol used by sending device 12, then the sending device 12 can bypass the gateway device 10.

Second, the sending device 12 uses a lookup table 42 within sending device 12 to determine the destination device type of the destination device 14. Presumably, this is how the sending device 12 can determine whether the sending device 12 and the destination device 14 use the same communication protocol, and thus can bypass the gateway device 10. In any event, once the sending device 12 determines the destination device type of the destination device 14, a gateway device “of the type asked for [by the sending device 12] will reply if one is available”. In other words, there are different types of gateway devices. Some gateway devices convert communication protocol A to communication protocol B. Other gateway devices convert communication protocol A to communication protocol C. However, in order for the sending device 12 to “ask for” the gateway device of the proper “type”, it must know the communication protocol of the destination device and it must find the gateway device that will convert communication protocol A of the sending device 12 into the communication protocol of the destination device 14. Thus, the sending device 12 must be aware of the communication protocol being used by the destination device 14.

Thus, Greaves does not teach at least the above-recited elements as set forth in claims 1, 11, 16 and 24.

For at least the above reasons, it is respectfully submitted that the obviousness rejection based, at least in part, on Greaves be withdrawn with respect to claims 1, 11, 16 and 24 and its rejected dependent claims (i.e., claims 2-10, 12-15, 17-23 and 25-28).

Independent claims 1, 11 and 24 recite communicating or communication over “a wireless link in accordance with a first protocol”. Independent claim 16 recites “communication with a device over a wireless link in accordance with a first protocol” in the preamble which may or may not carry patentable weight. However, for the discussions below, *for the sake of argument only*, it will be assumed that the preamble in claim 16 carries patentable weight.

The Examiner admits that Greaves does not teach a wireless link in accordance with a first protocol. Nevertheless, the Examiner states that a wireless link in accordance with a first protocol would have been obvious to support mobility. Applicant respectfully requests that the Examiner provide documentary evidence that the system in Greaves was made to support mobility.

Applicant respectfully challenges the assertion that a wireless link in the context of the claimed inventions as set forth in claims 1, 11, 16 and 24 would be well known or obvious.

Applicant respectfully draws the attention of the Examiner to M.P.E.P. § 2144.03(E) which clearly states that

[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Greaves does not teach any advantage for mobility as asserted by the Examiner.

Accordingly, Applicant respectfully submits that the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

Applicant further submits that Bork and Greaves were improperly combined and that an obviousness rejection based, at least in part, on Bork cannot be maintained.

With respect to the particular claims that were rejected as being obvious over Greaves in view of Bork: it is respectfully submitted that the Appeal Brief filed January 17, 2006 ("Appeal Brief") was deemed persuasive since the Examiner re-opened prosecution and withdrew the rejection based solely on Bork.

In fact, if the Examiner reconsidered the Appeal Brief in view of the alleged rejection, the Examiner would note that Bork taught away from the claimed inventions as set forth in claims 1, 11, 16 and 24. M.P.E.P. § 2145(X)(D)(1) states that "[a] prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness". M.P.E.P. § 2145(X)(D)(1) at page 2100-161 (Rev. 5, Aug. 2006).

Applicant has attached the relevant excerpts from the Appeal Brief in an enclosed Appendix as a courtesy to the Examiner and to provide evidence in support of the assertion that Bork teaches away from the claimed invention as set forth, for example, in claim 1 which recites "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device". Accordingly, Bork also teaches away from the other

independent claims that recite the same or similar language and thus Bork teaches away from the claimed inventions as set forth in the other independent claims. According to M.P.E.P. § 2145(X)(D)(1), this should be considered as a “significant factor in determining obviousness”.

In fact, if Greaves, as alleged by the Examiner, teaches “wherein the electronic system does not have to be aware of the first protocol to be in communication with the device” as set forth, for example, in claim 1, then, in view of the above discussions and the excerpts of the Appeal Brief, Bork must necessarily teach away from Greaves. M.P.E.P. § 2145(X)(D)(2) concludes that “[i]t is improper to combine references where the references teach away from their combination”. M.P.E.P. § 2145(X)(D)(2) at page 2100-161 (Rev. 5, Aug. 2006).

In view of at least M.P.E.P. § 2145(X)(D)(1) and M.P.E.P. § 2145(X)(D)(2), it is believed that an obviousness rejection based, at least in part, on Bork cannot be maintained.

It is therefore respectfully requested that the obviousness rejections based, at least in part, on Bork be withdrawn with respect to claims 3-10, 12-15, 17-23 and 25-28.

Applicant has amended claim 16. Support for the amendment can be found, for example, in the specification at paragraph [00018]. It is believed that claim 16 is in condition for allowance.

Inherency Doctrine

Applicant again respectfully repeats the challenges relating to the continued misapplication of the inherency doctrine with respect to claims 8, 9 and 23 and claims 14 and 15 and claims 7, 22 and 28 in spite of a persuasive Appeal Brief disputing the appropriateness of the use of the inherency doctrine.

Applicant has previously and strenuously challenged the misapplication of the inherency doctrine with respect to these claims during the prosecution of the present application.

For example, Applicant clearly addressed the inherency issues in the Appeal Brief which Applicant incorporates herein by reference in its entirety.

With respect to claims 8, 9 and 23, Sections III and IV on pages 9-11 of the Appeal Brief persuasively challenge the assertion of inherency and request that the Examiner provide documentary evidence in support of the Examiner's assertions.

With respect to claim 14 and 15, Section V on pages 11-12 of the Appeal Brief persuasively challenges the assertion of inherency and requests that the Examiner provide documentary evidence in support of the Examiner's assertions.

With respect to claims 7, 22 and 28, Section VI on pages 12-13 of the Appeal Brief persuasively challenges the assertion of inherency and requests that the Examiner provide documentary evidence in support of the Examiner's assertions.

Applicant respectfully submits that the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2). Otherwise, the rejection should not be maintained.

Conclusion

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-28 are in condition for allowance. If anything remains in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, any fee deficiencies and any credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: December 20, 2006

Respectfully submitted,

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APPENDIX

ARGUMENT FROM APPEAL BRIEF

I. Group I: Claims 1-5, 10-13, 16-20 and 24-27

Claims 1-5, 10-13, 16-20 and 24-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Bork patent.

Independent claims 1 and 24 recite, in part, “wherein the electronic system does not have to be aware of the first protocol to be in communication with the device”. Independent claim 11 recites, in part, “the electronic system not having to be aware of the first protocol to be in communications with the device”. Independent claim 16 recites, in part, “wherein the personal computer does not have to be aware of the first protocol to be in communication with the device”. Appellant respectfully submits that the Bork patent does not describe at least these elements as set forth in independent claims 1, 11, 16 and 24.

In the Office Action Made Final of June 22, 2005 (“the Final Office Action”) at page 4, the Examiner states that “the electronic system does not have [to] be aware of the first protocol to be in communication with the device because the protocol translation is performed by the BlueTooth USB Firmware. Since Bluetooth USB firmware is already in place to provide protocol translation, the electronic device does not need to be aware of the first protocol of the device.” Final Office Action at page 4.

Appellant respectfully submits that the logical argument presented in the Final Office Action makes assumptions not described in the Bork patent. For example, just because the Bork patent describes a USB driver 62 with Bluetooth USB firmware and a USB device controller, as illustrated in FIG. 19, it does not necessarily follow that the electronic system (which is alleged to be portable computer 70) does not have to be aware of the first protocol (which is alleged to be the Bluetooth protocol). Appellant respectfully notes that the Final Office Action did not provide a citation to the Bork patent which clearly demonstrates that “[s]ince, Bluetooth USB firmware is already in place to provide protocol translation, the electronic device does not need to be aware of the first protocol of the device”. See Final Office Action at page 4 (without citation to the Bork patent). Accordingly, Appellant respectfully submits that the Examiner has

not provided evidence in the Bork patent that the portable computer 70 or PC 10, for example, does not have to be aware of the first protocol to be in communication with the device.

In fact, the portable computer 70 or PC 10 is aware of the Bluetooth protocol (which is alleged to be the first protocol). FIG. 19 of the Bork patent is substantially relied upon as evidence by the Examiner; however, it is shown in FIG. 19 of the Bork patent that PC HCI Library of the portable computer 70 is in communication with Bluetooth HC of cradle 46; and USB Function Driver of the portable computer 70 is in communication with Bluetooth USB Firmware. FIG. 19 of the Bork patent suggests that the portable computer 70 is aware of the Bluetooth protocol.

FIG. 18 of the Bork patent also provides rebuttal evidence that the portable computer 70 or PC 10 is aware of the Bluetooth protocol during communications with the device. According to the Bork patent, "FIG. 18 illustrates a high level block diagram of the relevant portions of personal computer 10 that enable the computer to communicate with the Bluetooth radio in cradle 46". In particular, FIG. 18 illustrates a Bluetooth Adviser 68. Appellant respectfully submit that, if the computer 10 has a Bluetooth Adviser, then the computer 10 is aware of the Bluetooth protocol.

The specification of the Bork patent with respect to FIG. 18 also states the following:

Computer 10 also **requires** Bluetooth profiles 60, such as found in the Bluetooth Profile Specification, which can be found at www.Bluetooth.com or www.Bluetooth.net, hereby incorporated by reference, which are applications that insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility at the application layer so that if, for example, data synchronization is required, the computer knows how to do data synchronization with mobile device 54 (see for example, FIG. 21 in the Profile Stack section on page 171 of the Bluetooth Profile Specification). Computer 10 can be enhanced by the addition of an application 60 that enables the user to configure, control, and use all Bluetooth devices that are connected to a computer (e.g., application such as Bluetooth Adviser—see WinHEC 99 White Paper submitted herewith, or Bluetooth Neighborhood—see also www.Bluetooth.net). In the event that computer 10 is to be coupled to cradle 46 via a Universal Serial Bus "USB", the computer 10 also requires

a USB driver 62 in addition to a PC operating system 61, such as Microsoft's Windows 98.

The Bork patent at col. 6, lines 26-36 (bold and underlining of "Computer 10" and "requires" added for emphasis). Appellant respectfully submits that, since the computer 10 requires Bluetooth profiles, the computer 10 is aware of the Bluetooth protocol.

Applicant respectfully submits that, since PC 10 requires (i.e., it is not optional so as to permit the Examiner's alleged characterization of the Bluetooth USB Firmware as set forth in the Final Office Action at page 4) Bluetooth profiles 60 and other Bluetooth applications to "insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility at the application layer", the electronic system (which is alleged to be the PC 10) has to be aware of the first protocol (which is alleged to be the Bluetooth protocol).

To maintain an anticipation rejection, each and every element as set forth in independent claims 1, 11, 16 and 24 must be described in the Bork patent. For at least the above reasons, Appellant respectfully submits that each and every element as set forth in independent claims 1, 11, 16 and 24 is not described in the Bork patent.

It is therefore respectfully requested that the Board reverse the rejection with respect to claims 1-5, 10-13, 16-20 and 24-27.

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VI. Group VI: Claims 7, 22 and 28

Claims 7, 22 and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Bork patent.

The arguments made above in section I with respect to claims 1, 16 and 24, from which claims 7, 22 and 28 depend, respectively, are incorporated herein and made with respect to claims 7, 22 and 28. For at least these reasons, the Board is urged to reverse the rejection with respect to claims 7, 22 and 28.

In the Final Office Action at page 3, the Examiner alleges that “Re Claims 7, 22, 28, the USB device controller coupled to the inherently includes the USB protocol stack”.

Appellant respectfully challenges the assertion that the elements in claims 7, 22 and 28 in combination with claims 1, 16 and 24, respectively, are all inherent. Appellant believes that the Examiner improperly applied the doctrine of inherency for the reasons stated above as set forth in Section II, which is incorporated herein in its entirety.

Appellant respectfully submits that the elements recited in the claims 7, 22 and 28 might be probable or possible elements, but are not necessary elements. In other words, if components and relationships other than the elements recited in the claims could be used, then the doctrine of inherency does not apply.

Claim 7 recites, in part, “wherein the system communication module further includes a USB protocol stack, the interface unit further including a USB interface operatively connected to the USB protocol stack”. It is not all necessary that a system communication module necessarily include a USB protocol stack. Claim 1 from which claim 7 depends is not so limited as to be used only with a USB protocol.

Claim 22 recites, in part, “wherein the system communication module further includes a USB protocol stack, the interface unit further including a USB interface operatively connected to the USB protocol stack”. It is not all necessary that a system communication module necessarily include a USB protocol stack. Claim 16 from which claim 22 depends is not so limited as to be used only with a USB protocol.

Claim 28, recites, in part, “wherein the system communication routine utilizes a USB protocol stack in processing information received from the electronic system and translated data received from the translation routine”. It is not at all necessary that a system communication routing always utilize a USB protocol stack. Claim 24 from which claim 28 depends is not so limited as to be utilize only a USB protocol stack.

For at least the above reasons, it is respectfully requested that the Board reverse the rejection based on the inherency doctrine or that the Board compel the Examiner to either produce references in support of the Examiner’s contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, compel the Examiner to

U.S. Application No. 09/844,625, filed April 27, 2001
Amendment dated December 20, 2006

In Response to Office Action mailed September 20, 2006

provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).